

**Remarks**

Claims 1, 3-13 are pending. Applicants have amended claims 10 and 13 herein.

Claims 10-13 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention.

Claims 1 and 3-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slade et al. (U.S. Pat. No. 5,550,735) in view of Foresman et al. (U.S. Pat. No. 5,099,422).

Applicants respectfully traverse the rejections and request reconsideration based on the amendments and remarks made herein.

**Rejections under 35 U.S.C. 101**

Claims 10-13 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. Applicants respectfully traverse the rejection; however to advance prosecution, Applicants have amended claims 10 and 13. Applicants respectfully submit that the claimed subject matter is positively tied to a particular machine and a transformation occurs at least in the steps of “selecting from an interface an advertising template” and “assembling by a processor said personalized advertisement using said advertisement template and said selected media segments.” Claim 10, 13; see also *In re Bilski*, 545 F.3d 943, 88 U.S.P.Q.2d 1385, 1397 (Fed. Cir. 2008) (electronic transformation of data into a visual depiction is sufficient). Thus, Applicants respectfully submit that claims 10 and 13 positively recite patentable subject matter and therefore satisfy the requirements of 35 U.S.C. § 101. Further, dependent claims 11 and 12, by virtue of their dependence on a proper base claims, include patentable subject matter.

**Rejections under 35 U.S.C. 103(a)**

Claims 1 and 3-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slade et al. (U.S. Pat. No. 5,550,735) in view of Foresman et al. (U.S. Pat. No. 5,099,422). Applicants respectfully state that one skilled in the art would not combine the cited teachings of Slade and Foresman because Slade teaches away from both the teachings of Foresman and the claimed invention.

As the Office action admits, Slade fails to disclose “the plurality of expert rules and of an advertisement assembly component which uses those rules in order to get appropriate media segments for each of said media segment slots of said advertisement.” To cure this deficiency, the Office action cites to Foresman’s teaching of a computer program having algorithms embodying formulae or rules to determine which recipient receives which information segments.

When analyzing the scope and content of the cited references, it is clear that while Slade does teach compiling and mass-producing customized media, the scope of those teachings is limited to systems requiring user-selection of video and music segments. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Applicants respectfully submit that the combination of Slade and Foresman is improper because Slade teaches away from the Foresman reference as well as away from the claimed invention. Slade teaches a system for the mass production of pre-determined customized videotapes or disks specifically based on user-interaction, specifically:

[T]he system of this invention provides a new and improved compiling system which enables a high volume of customized media utilization devices, such as cable television channels, videocassette tapes, videotapes, or other such devices, to be produced in a highly efficient and

cost effective manner. Each medium device contains pre-recorded information segments, such as music video segments, **selected by an end user recipient. Such a customized storage media can be utilized by the end user recipient, on widely available conventional videocassette players, audio cassette players, and other such devices.**

*Slade* Col. 2, ll. 46-56 (emphasis added).

User-interaction is so vital to the Slade system, in fact, that Slade even recites in its claims the “user information signals indicative of all of said customized information segment sequences to be compiled” and “allocating means coupled to said processing means for allocating said resource means to said destination means on a time sharing basis according to said user information signals for enabling each one of said destination means to access the information segments stored on said resource means.” *Slade*, Claims 1, 9, and 12 (emphasis added). Because the user interaction is so vital to the invention of Slade, no other means of selecting content are disclosed, suggested or contemplated by the Slade disclosure. Removing the user interaction from the teachings of Slade would render Slade’s invention useless.

Further according to Slade, “raw data 201 stored in the database memory of the data pre-processor 36 is retrieved and reassembled as processed data 203 **as determined by end user requirements**”. *Slade*, col. 5, ll. 54-57 (emphasis added). The system of Slade is predicated on end-user interaction to select the contents of the videotape

Because the Slade disclosure requires the user interaction and selection of media content, there is no need for a rule set as claimed by Applicants. There is no discussion of a need for a rule set, nor would the inclusion of a rule set provide the Slade invention with any advantage. Slade specifically teaches away from a vital element of the claimed invention, specifically, the generation and assembly of a personalized advertisement without interaction by said intended audience. Applicants’ independent claims specifically recite, “a non-interactive personalized

advertisement” with “assembly performed without interaction by said intended audience.” (See Claims 1, 10 and 13).

Even the cited portions of Foresman directly contradict the teachings of Slade:

[T]he program has algorithms embodying formulae or rules to determine which recipient receives which information segments. The computer 900 then causes the compilation of the customized information and assembles the information onto an appropriate individual recording media 970 for distribution to the recipient who then can utilize the media 970 on his or her own play-back device...

Foresman, Col. 6, ll. 26-30. One skilled in the art would not look to combine these two references because, simply put, to do so would obviate the teachings of each reference, i.e., Slade requires user-interaction to select media, Foresman requires computer formulae to select media. There is no objective evidence in either reference that one skilled in the art would combine the references. To the contrary, ample evidence exists that the references teach away from each other and the claimed invention.

Based on the foregoing, Applicants submit that the combination of Slade and Foresman is improper. Applicants submit that independent claims 1, 10 and 13 are patentably distinct from the cited references and are in condition for allowance. Applicant further submits that dependent claims 3-9 and 11-12, by virtue of their dependence on allowable base claims are also in condition for allowance.

### **CONCLUSION**

For at least the reasons outlined above, Applicants submits that this application is in condition for allowance and requests favorable action in the form of a Notice of Allowance. Please apply any charges or credits to Deposit Account No. 08-0570.

If, in the Examiner's opinion, a telephonic interview would expedite the favorable prosecution of the present application, the undersigned attorney would welcome the opportunity

to discuss any outstanding issues, and to work with the Examiner toward placing the application in condition for allowance.

Respectfully submitted,

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